

## REMARKS

Applicant requests favorable reconsideration of this application in view of the foregoing amendments and the following remarks. Claims 1-23 and 25 were pending in the application and were rejected in the Office Action. By way of this amendment, Applicant has: (a) amended claims 1, 5, 6, 12, and 25; and (b) added new claims 26-31. The Examiner is precluded from issuing a first-action, Final Office Action due to at least the addition of new claims 26-31. Accordingly, claims 1-23 and 26-31 are respectfully pending for further consideration.

### **1. Information Disclosure Statement**

Applicant appreciates the indication that the Examiner considered the references submitted with the Information Disclosure Statement ("IDS") filed on November 18, 2004.

### **2. Rejection of Claims 1-23 and 25**

The Office Action again rejected: (a) claims 1-19, 21-23, and 25 under 35 U.S.C. § 103(a) as allegedly being obvious when considering U.S. Patent No. 4,810,084 ("Nyui") in view of U.S. Patent No. 6,305,801 ("Kerns"); and (b) claim 20 under 35 U.S.C. § 103(a) as allegedly being obvious when considering Nyui in view of Kerns and further in view of U.S. Patent No. 6,271,968 ("Dobrowolski"). For at least the following reasons, Applicant respectfully continues to traverse each of these rejections.

As amended herein, claim 1 recites an optical device that includes, among other possible things (*italic emphasis added*):

*a housing, the housing comprising:*

*a light source emitting light along an illuminating beam having  
a two-dimensional cross-sectional area;*

*a main objective; and*

*a spectral filter positioned between the light source and the  
main objective,*

*wherein the spectral filter is adapted to reduce, without eliminating, the  
intensity of the light emitted by the light source in a specific region, the  
specific region being a subsection of the two-dimensional cross-sectional area  
of the illuminating beam.*

Preliminarily, Applicant hereby incorporates each of the arguments previously set forth in the Amendment and Reply filed on April 15, 2005. In addition, as hereafter explained, the combination of Nyui and Kerns (and Dobrowolski) can not be used to reject claim 1, or any claim dependent thereon under 35 U.S.C. § 103(a), for at least these additional reasons.

In maintaining the rejection of claim 1, the Examiner states:

The instant claim does not delimit a main objective *lens*, or any other specific component or element that can be considered a physical part of the claimed device. Thus, the Examiner must read the phrase “main objective” in its broadest reasonable interpretation. . . . Though the “main objective” in the claim is recited after the preamble “[a]n optical device comprising,” the broadest reasonable interpretation of the claim does not limit the “main objective” to an actual physical component of the device. Said “main objective” can be considered to be the object upon which the light is impinging.

See Office Action at p. 2 (*italic emphasis in original, underline emphasis added*). In response to this interpretation of the claim, Applicant has opted to amend claim 1 to recite more clearly that the objective is part of “an actual physical component of the device” and that such physical component also includes a light source and a spectral filter.

Specifically, Applicant has amended claim 1 to recite that the light source, the spectral filter, and the objective are all part of a “housing” that, in turn, is part of the optical device. Support for this amendment is provided, for example, in ¶¶ [0017] (stating that the optical device is constructed in various parts), [0022] (stating that the apparatus is designed to “protect” an eye, which eye, therefore, can not be considered to be part of the apparatus), and [0039] (stating that the device may be, *e.g.*, part of a surgical microscope, a projector, a video camera, a photographic camera, etc.). By amending claim 1 to recite that the main objective is part of a housing that also includes the spectral filter and the light source, Nyui’s eyeball 4 cannot be fairly analogized to the “main objective” recited in claim 1, respectively. In other words, Nyui’s eyeball 4 is not part of a housing (*i.e.*, “actual physical component”) that also includes a light source and a spectral filter. As Kerns fails to teach or suggest a main objective and instead teaches a contact lens, Kerns can not be used to cure Nyui’s deficiencies when Nyui’s eyeball 4 is analogized to the “main objective” recited in claim 1. Similarly, as Dobrowolski fails to teach or suggest a main objective and instead teaches cut-off filters that lack localized differences in the amount of light transmitted, Dobrowolski also can not be used to cure Nyui’s deficiencies when Nyui’s eyeball 4 is analogized to the “main objective” recited in claim 1.

To the extent Nyui’s objective lens 13 may be analogized to the main objective recited in claim 1, the rejection based on Nyui and Kerns is still flawed for at least the following reasons. M.P.E.P. § 2143.01(V) provides: “If proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification.” M.P.E.P. 2143.01(V) (citing *In re Gordon*, 733 F.2d 900, 221 U.S.P.Q. 1125 (Fed. Cir. 1984)). Kerns teaches that the

contact lens 10 described therein may be “either a hard or soft contact lens body.” If one of ordinary skill in the art were to use a soft contact lens of the type taught by Kerns in the optical device taught by Nyui, the resultant device would fail to work properly because the contact lens would shrivel due to lack of hydration. Similarly, if one of ordinary skill were to use a hard contact lens of the type taught by Kerns in the optical device taught by Nyui, the resultant device would fail to work properly for at least the following two reasons. First, the contact lens 10 would converge or diverge the light emitted by the light source, thereby negatively impacting the light field eventually reaching Nyui’s lens 13 (*i.e.*, the “main objective”). For example, as a result of a convergent contact lens, the light that passes through the lens may be convergent on the middle panel of Nyui’s aperture 10, thereby preventing any light from passing through Nyui’s aperture 10 and reaching Nyui’s lens 13 (*i.e.*, the main objective). Second, as a result of the concave shape of the contact lens, the lens presumably could not even structurally replace Nyui’s planar spectral filter 20.

For at least the foregoing reasons, it is clear that any combination of Nyui, Kerns, and Dobrowolski fails to teach or suggest at least the above-italicized limitations of claim 1. As a result, the combination of Nyui, Kerns, and Dobrowolski can not be used to reject claim 1, or any claim dependent thereon, under 35 U.S.C. § 103(a). Moreover, as claims 2-23 and 25 depend from claim 1, each of these dependent claims is also allowable over Nyui, Kerns, and Dobrowolski, without regard to the other patentable limitations recited therein. Accordingly, a withdrawal of the various rejections of claims 1-23 and 25 under § 103(a) is both warranted and respectfully requested.

### **3. New Claims 26-31**

New claim 26 (*i.e.*, the claim from which new claims 27-31 depend) recites a surgical microscope that includes, among other possible things (*italic emphasis added*):

an optical device *housing* comprising:

*a light source* emitting light along an illuminating beam having a two-dimensional cross-sectional area;

*a main objective*;

*a spectral filter* that is configured to be positioned between the light source and the main objective, wherein the spectral filter is:

(a) adapted to reduce, without eliminating, the intensity of the light emitted by the light source in a specific region, the specific region being a subsection of the two-dimensional cross-sectional area of the illuminating beam; and

- (b) configured to be displaced vertically and/or horizontally when positioned between the light source and the main objective; and
- a control circuit configured to control the vertical and/or horizontal displacement of the spectral filter.

As previously discussed with respect to claim 1, any combination of Nyui, Kerns, and Dobrowolski fails to teach or suggest a housing that includes a light source, a spectral filter, and a main objective. As new claim 26 recites an optical device housing that includes a light source, a spectral filter, and a main objective, new claim 26 is allowable over the combination of Nyui, Kerns, and Dobrowolski for at least the same reasons as claim 1. Moreover, as new claims 27-31 depend from new claim 26, each of these new dependent claims is also allowable over any combination of Nyui, Kerns, and Dobrowolski, without regard to the other patentable limitations recited therein.

### CONCLUSION

For the aforementioned reasons, claims 1-23 and 26-31 are now in condition for allowance. A Notice of Allowance at an early date is respectfully requested. The Examiner is invited to contact the undersigned if such communication would expedite the prosecution of the application.

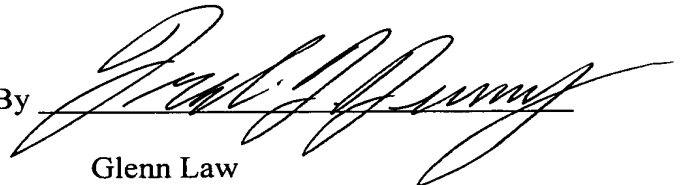
Respectfully submitted,

Date March 29, 2006

Customer Number: 22428  
FOLEY & LARDNER LLP  
3000 K Street, N.W.  
Suite 500  
Washington, D.C. 20007-5143

Telephone: (202) 672-5300  
Facsimile: (202) 672-5399

By



Glenn Law  
Registration No. 34,371

Frederic T. Tenney  
Registration No. 47,131

Attorneys for Applicant

THE COMMISSIONER IS HEREBY AUTHORIZED TO CHARGE ANY ADDITIONAL FEES WHICH MAY BE REQUIRED REGARDING THIS APPLICATION UNDER 37 C.F.R. §§ 1.16-1.17, OR CREDIT ANY OVERPAYMENT, TO DEPOSIT ACCOUNT NO. 19-0741. SHOULD NO PROPER PAYMENT BE ENCLOSED HEREWITH, AS BY A CHECK BEING IN THE WRONG AMOUNT, UNSIGNED, POST-DATED, OTHERWISE IMPROPER OR INFORMAL OR EVEN ENTIRELY MISSING, THE COMMISSIONER IS AUTHORIZED TO CHARGE THE UNPAID AMOUNT TO DEPOSIT ACCOUNT NO. 19-0741. IF ANY EXTENSIONS OF TIME ARE NEEDED FOR TIMELY ACCEPTANCE OF PAPERS SUBMITTED HEREWITH, APPLICANT HEREBY PETITIONS FOR SUCH EXTENSION UNDER 37 C.F.R. § 1.136 AND AUTHORIZES PAYMENT OF ANY SUCH EXTENSIONS FEES TO DEPOSIT ACCOUNT NO. 19-0741.